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EXAMINER	
RUHL, DENNIS WILLIAM	
ART UNIT	**PAPER NUMBER**
3629	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/776,619	BABU, SURESH RANGASWAMY	
	Examiner	Art Unit	
	Dennis Ruhl	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-19 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 4/19/04; 8/26/04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 7-9,15-19, are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

1. Whether the invention is within the technological arts; and
2. Whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

For claims 7-9, there is no recitation of any technology or anything that would fall within the "technological arts". All of the steps can be done by a person(s) making a visual comparison of performance data (did something break or work properly?) to see if something passes or fails the test benchmark. No technology is required in the claim's scope and nothing is being manipulated in any manner so the claims are considered to be non-statutory.

3. Claims 15,16,17-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For claims 15,16, the claims are not considered to be reciting statutory subject matter. Applicant is reciting a system that can fairly be interpreted to read on a paper notebook of data (a recall repository and template) and a human being (the recall management agent). Applicant has defined the recall agent in terms of what it does and this language reads on a person and some data on paper. Claims 15,16, are not considered to be statutory by the examiner.

For claims 17-19, the claims are considered non-statutory. The claims have a scope that includes an intangible medium ,such as a signal or transmission (a medium) that contains instructions to do what has been claimed. A signal is not considered to be statutory subject matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 10, the preamble recites "a recall notification method" but the examiner takes notice that the body of the claim does not recite anything about a recall notification. Establishing a session, classifying an audience member into a type, and regulation access do not result in recall notification, which is what the preamble

indicates the claim is directed to. It is not clear what the scope of this claim is. There must at least be a step of notifying someone of a recall as far as the examiner is concerned. Is a recall notification being done in claim 10 or is the scope such that it does not include a recall notification?

For claim 12, it is not clear as to whether the claim is reciting the transmission of a report ("to a member"), or if the claim is just reciting the generation of the report. "Generating a report to a member" as claimed is not clear as to whether just generation of a report is claimed or if transmission to a member is being claimed.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by the very well known practice of a "product recall" as has been done with children's products (safety seats, cribs, high chairs, etc.), automotive related products (defective tires) and numerous other types of items/products.

For claims 7-9, it is a well-known fact that many products in society are subject to a product recall, usually resulting from some sort of product related defect or safety

concern. The recalling of a product inherently involves the comparison of product performance data to benchmarks to determine if a product needs to be recalled. This could be comparing data that indicates a child or children have died due to some defect in a crib or safety seat, where the benchmark is that if a product causes death in a child, the product is to be recalled. This could also be a comparison of how a tire should perform under normal operating conditions and after data indicates that huge numbers of a given type of tire are failing and causing death and serious injury to many people, deciding to recall the tires. The product recall is an alert to society that a particular product is defective so they can avoid further injury by using the recalled product.

With respect to the recitation of "statistical limits" in claim 8, this is inherently found in a product recall because if the particular defect is occurring at a rate that is not acceptable, the product will have to be recalled. The "statistical limit" will vary depending on the given product but the decision to recall a product is made by assessing to what extent the product is failing and assessing the risk associated with the product. If one child is killed because of a defect in a car safety seat that should not have occurred, one death is enough to have the seat recalled. Statistical limits inherently are looked at during a product recall.

For claim 9, determining the extent to which products are proliferated (that may be recalled or are being recalled) is inherently part of the process of a product recall. Clearly if you have not shipped any of the products to market, there is no need for a recall. In other words, the assessment of whether or not there is even one of the defective products in the public satisfies what is claimed. On the other hand, if it is

found that a car safety seat is failing that is in public use, one would necessarily figure out how many have been sold and try to determine to what extent they are out in the market being used. One way to do this is the well known fact that the product registration forms that have been filled out by the purchaser of the product are used by companies to contact the consumers that have purchased a recalled product.

8. Claims 7,8,17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Moore (6370454).

Applicant should take notice that there are two interpretations for claim 17 based on the scope of the claim.

For claims 7,17-19, Moore discloses a computer system that compares sensor data to data benchmarks to determine if a problem exists. If no problem is found, this situation anticipates what is claimed (the language about the alert only is present if a failure is detected). Moore also anticipates claims 18 and 19 because what is claimed is only present if a failure (defective product) is noted. Claims 7,17 cover the situation where a product fails (generating an alert) and where a product passes (nothing else required in the claim).

Claims 8,17,18, are also anticipated because if a failure is found, an alert is generated as claimed. This problem is inherently deemed previously undetected because there was no problem previously noted. See figure 4 and 5 which show two screens for 1) vehicle status and 2) a problem screen. Also see column 7, lines 57-58 where it is disclosed that an indicator is flashed if a problem is noted. Claim 18 is

anticipated if the problem is a new problem (not detected previously). Because a new problem inherently has not been detected previously, the specifics of claim 18 are not required.

9. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Abreu (2001/0056359).

For claims 10,11, Abreu discloses a recall notification method as claimed. The system informs consumers about product recalls and of potentially harmful products. Abreu discloses establishing a session between a notification agent 10 and a terminal (user computer 30 or anyone that connects to agent 10). The users are classified into groups of audiences because the system interacts with many users or sources of data. Some audience members are simply for the acquisition of data to be used by the system and other members are persons interested in information about recalls. Access to information is regulated because a manufacturer cannot use the system to access information in a consumer's account and the consumer cannot use the system to access the data gathered from a manufacturer. See paragraph 142. Who you (audience type) are determines whether you have access or not to information in a given file.

For claims 12,14, see paragraph 128-131, where the alert process is disclosed.

For claim 13, when the system has determined an alert needs to be sent out, this conforms to a time according to a template. The template is that whenever a certain situation occurs, the system should send an alert.

For claim 15, the recall template is found in Abreu because the system inherently has stored instructions on what procedure is to be used to notify a given customer of the desired recall or other information. This could be emailing or auto dialing of a phone, or whatever mode of communication is selected by the customer. The recall repository is database 514. The recall agent is system 10 and operates as claimed. The system identifies consumers that have a desire for certain information (para. 128), transfers information to the identified consumers, and inherently tracks the receipt of the information. Phone calls, pages, etc. are all recorded. Autodialing inherently has receipt of notification being recorded (the call happened).

For claim 16, see paragraph 234, lines 12-17. Approval by the health plan for a doctor visit or a test is a form of an authorization to perform remediation. Compensation will then be provided to the "service technician" as claimed.

For claims 1,4,5,7,8,9,17,18,19, see paragraph 251 where it is disclosed that in response to performance data (any kind of data about a product or biological variables of patients using a certain drug), the system can compare the data to "criteria for potential harmful effect" (a benchmark), and if needed, notify affected consumers that a new defect or problem has been identified based on the performance data. This is an early warning system as claimed in claim 1. The recall operations system and recall repository is the part of the system that stores the desired manner of communication for the consumer (email, phone, etc.). If the defect is newly noted, claims 8,18 are not required as they only cover the situation when a defect has been previously noted. The notification of affected consumers is a form of diffusion modeling, because the

identifying of the consumers is a determination as to the extent of the problem (how many people are using a particular drug or product and need to be informed).

For claims 2,3,6, the cockpit application is considered to be communication software (i.e. modem drivers) that manages communications. The intended use that recites who the system of Abreu may communicate with, defines nothing to the system itself and has been considered only to the extent that the prior art is capable of communicating with a customer, someone from the media, etc..

10. Claims 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Busche et al. (6714893).

For claims 10-12,14, Busche discloses the establishment of a session between a notification agent (the system of Busche) and a terminal (a subscriber/source of recall/product data). Busche discloses a system that sends recall information (a report from report wizard 434) to subscribers via a network (Internet). The terminal of a subscriber (a citizen or a company or anyone) is an audience type, they are subscribers. Access is regulated because only information relevant to a subscriber is sent out in the report. This is a form of regulating access by only sending information that is deemed relevant. See column 7, lines 12-24. With respect to the language "the report structured according to a report template that is specific to the respective audience member type" is taken as non-functional descriptive material that is not given patentable weight. Additionally, the limitation really does not mean anything anyway, because it is so broad in scope. The limitation is really just reciting that the report has a

format (template), which all reports inherently have. The language about being specific to a member defines nothing to the template and one can consider this to be satisfied by the fact that the report details only products of interest to the subscriber (a customized report based on the subscriber) .

For claim 13, Busche sends out a report when stored criteria (results of data analysis) triggers the system to send out a report. For example, see column 5, lines 21-52 where this is disclosed.

11. Claims 1-6,15,16 are rejected under 35 U.S.C. 102(e) as being anticipated by Mansfield Jr. (2004/0267608).

For claim 1, Mansfield discloses a system as claimed. The early warning system is inherent in step 210. A system of some kind is necessary to decide to generate an alert. The recall system and notification system is 10 and the recall repository is database 20. The recitations to what kind of data is being stored is interpreted as being non-functional descriptive material that does not get patentable weight. Data is data, and the type of data being stored will not be considered as defining over the prior art, when the system is structurally the same as the prior art.

For claim 2, the cockpit application is considered to be software in Mansfield that runs or controls the communications (a modem driver).

For claims 3,5,6, the claims are reciting non-functional descriptive material that does not get patentable weight. The type of "external entity" or "audience classification"

and a "reporting template" are just data and are not functionally related to the recall system itself.

For claim 4, the recitation of "to perform product distribution" is not taken as a positive recitation of a step because the step is not being recited as being performed. Additionally, the identification of consumers in Mansfield is a form of product distribution modeling. It is a way to see how much of a given product is out in the public.

For claim 15, Mansfield discloses a recall repository (database 20) and a recall agent (processor 10). The recall agent identifies consumers that purchased a recalled product and notifies them of the recall. Paragraph 45 discloses that information for consumers that received information is evaluated. Received information equates to a recording receipt of the information as claimed. Paragraph 27 discloses a template as claimed (even though the template itself is non-functional descriptive material and gets no patentable weight, the template is just data that is not functionally related to the system itself).

For claim 16, see paragraph 25, lines 1-3 for the disclosure of remediation being communicated (refund, rebate, etc.). Step 420, "Pay Recall Service Provider" satisfies the claimed "processes compensation" limitation.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Busche et al. (6714893).

For claim 15, Busche discloses a system that has a database (a recall repository). With respect to the "recall template", this is non-functional descriptive material that does not get patentable weight. A template is just data, which in article claims only get patentable weight if the data is functionally related to the product itself (in this case the system). This is not the case in claim 15. A template is not even a real physical thing but is intangible. Article claims are for real world things, not intangible things. The recall agent is the system of Busche that can ID subscribers, send them recall reports with recall information. Not disclosed is that the receipt by the subscriber of the report is recorded. It would have been obvious to one of ordinary skill in the art to record the receipt of the report by the subscriber so that you can ensure that a particular subscriber has been received the report (that may be of great interest to the subscriber).

15. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the "Tread Act" of Congress (Public Law 106-414-Nov. 1, 2000).

For claims 10,11, the "Tread Act" discloses establishing a session between an automated notification agent (the government) and a terminal (the manufacturer). The tread act requires that manufacturers submit certain information to the government concerning possibly defective products and injuries or deaths that may have been caused by a given product. The Tread Act also specifically discloses and suggests an "electronic form" for the data that must be submitted by the manufacturers. This clearly is a disclosure of using modern technology (computers) for data submission and would inherently involve the use of a terminal (manufacturer side) and an automated agent (the government). Also disclosed is that with respect to the information submitted to the government, it will be kept confidential unless the "Secretary" deems that the disclosure of the information is required to comply with certain statutory obligations. This is considered to be the regulation of information based upon who you are. If you are Ford Motor Co, you cannot gain access to GM data, and vice versa. It may also be that the manufacturer can only send data to the government, which means that the access to data is regulated in the sense that only the government can view the data. The government employees reviewing the data are considered to be the claimed regulators.

For claims 12,13,14, the examiner considers it inherent that if the government decides that a particular product must be recalled to protect the public at large, the creation of a recall notification report would inherently be done. Inherently the manufacturer of the product would be notified of the recall by the government. With

respect to the language "the report structured according to a report template that is specific to the respective audience member type" is taken as non-functional descriptive material that is not given patentable weight. Additionally, the limitation really does not mean anything anyway, because it is so broad in scope. The limitation is really just reciting that the report has a format (template), which all reports inherently have. The language about being specific to a member defines nothing to the template. For claim 13, the time of the report generation satisfies the "at a time" limitation because when a recall is deemed necessary (a milestone template) a report is generated.

16. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the very well known practice of a "product recall" as has be done with children's products (safety seats, cribs, high chairs, etc.), automotive related products (defective tires) and other types of items/products.

For claims 17-19, it is a well-known fact that various products in society are subject to a product recall, usually resulting from some sort of product related defect or safety concern. The recalling of a product inherently involves the comparison of product performance data to benchmarks to determine if a product needs to be recalled. This could be comparing data that indicates a child or children have died due to some defect in a crib or safety seat, where the benchmark is that if a product causes death in a child, the product is to be recalled. This could also be a comparison of how a tire should perform under normal operating conditions and after testing data indicates that huge numbers of a given type of tire are failing and causing death and serious injury to many

people, deciding to recall the tires. The product recall is an alert to society that a particular product is defective so they can avoid further injury by using the recalled product.

With respect reciting that the method steps are instructions stored on a computer readable medium, because of the exploding rate that our society uses computers to assist in managing data and conducting business, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a computer to perform the steps that are done in a product recall. Data on computers representing complaints by consumers, alleged injuries data, testing data, etc. would be used in a comparison to see if it looks like a product is failing. Cleary, if a tire company X received data that indicates that the their tires do not meet the Federal Government (DOT) minimal regulatory performance benchmarks, an alert will be generated (a report detailing data indicative of a failure, data itself indicating a failure, etc.).

With respect to the recitation of "statistical limits" in claim 18, this is inherently found in a product recall because if the particular defect is occurring at a rate that is not acceptable, the product will have to be recalled. The "statistical limit" will vary depending on the given product but the decision to recall a product is made by assessing to what extent the product is failing and assessing the risk associated with the product. If one child is killed because of a defect in a car safety seat that should not have occurred, one death is enough to have the seat recalled. Statistical limits inherently are looked at during a product recall.

For claim 19, determining the extent to which products are proliferated (that may be recalled or are being recalled) is inherently part of the process of a product recall. Clearly if you have not shipped any of the products to market, there is no need for a recall. In other words, the assessment of whether or not there is even one of the defective products in the public satisfies what is claimed. On the other hand, if it is found that a car safety seat is failing that is in public use, one would necessarily figure out how many have been sold and try to determine to what extent they are out in the market being used. One way to do this is the well known fact that the product registration forms that have been filled out by the purchaser of the product are used by companies to contact the consumers that have purchased a recalled product.

17. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over vehicle rollover disclosed in section 12 of the Tread Act (Public Law 106-414).

For claims 17-19, the claims read substantially on the testing for vehicle rollover disclosed in section 12 of the Tread Act (Public Law 106-414); however it is not disclosed that the steps are instructions stored on a computer readable medium.

Inherently when conducting a rollover test you are comparing performance data of some kind to data benchmarks. An example of a benchmark can be whether or not a vehicle rolls over in a given set of conditions. A rollover would indicate failing the test. The benchmark can also be vehicle stability data in many forms that indicate the stability of a vehicle in a given situation. The situation of a vehicle not rolling over (passing the benchmark) satisfies what is claimed. The portion dealing with a product

that fails and generating an alert is only required when a product fails. A product that passes a test (it has had performance data compared to a benchmark) substantially satisfies the claim. The claim covers a product passing the benchmark and one not passing the benchmark. With respect to having the comparison of data be instructions stored on a computer readable medium, it would have been obvious to one of ordinary skill in the art to use a computer to evaluate the test data for the rollover tests. The use of computers to evaluate test data has been done for decades and is the most obvious form of data collection and analysis (other than by hand). Claim 17 is basically reciting software/code for a computer to evaluate test data to make sure a product is in compliance with government regulations (a test benchmark).

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Montanari (5478990), Roberts et al. (2003/0069772), and Taschner (2003/00171974) disclose systems relevant to the claimed and disclosed invention. The "Tread Act Summary" discloses features of the tread act, which relates to product recalls.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DENNIS RUHL
PRIMARY EXAMINER